

*Applicants: Yi Li, et al.*  
*Serial No. 09/916,780*

## **REMARKS**

### **Status of the Claims**

Claims 1-49 and 60-62 are canceled. Claims 50-59 are presented for consideration.

### **Restriction/Election:**

Applicants elect claims 50-62 for examination. Applicants cancel claims 38-49 and 60-62, reserving the right to refile the non-elected claims in a divisional application. Applicants disagree with reasons for the restriction and with the objection to claim 49; however, in the interest of expediting prosecution have complied with making the election.

### **Objection to Claim 49:**

The amended claims are directed to the elected invention. This objection is moot due to the cancellation of claim 49. Elected claims have been amended to remove dependency on canceled claim 49.

## **REJECTION UNDER 35 USC §102, SECOND PARAGRAPH**

Claims 50-62 are rejected under 35 USC §112, second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

In an effort to provide additional clarity to the claims, Applicants have amended claims 50 and 51 in accordance with the examiner's helpful suggestions; however, Applicants do not agree with the rejection of claim 53.

Regardless of the examiner's definition of "trait", Applicants have clearly described "A gene that results in an altered plant phenotype is any gene whose expression leads to the plant exhibiting a trait or trait that would distinguish it from a plant of the same species not expressing the gene." See [0037]. The particular "traits" listed include "...different growth habit, altered flower or fruit color or quality, premature or late flowering, increased or decreased yield, mortality, disease

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susceptibility, altered production of secondary metabolites, or an altered crop quality such as taste or appearance." Applicants submit that they are entitled to use the term "trait" as they have defined it in the specification.

Trait is a "distinct alternative form of a characteristic" as defined in the Glossary in *Understanding Genetics*, by N.V. Rothwell (Wiley-Liss, New York, 1993, page 623). Characteristic is defined as "A general attribute of an organism." (Id. at 611). An attribute is defined in Webster as an inherent characteristic or a word ascribing a quality (Ninth New Collegiate Dictionary, 1989).

Accordingly, Applicants believe they are entitled to use the "traits" described in the specification; however, should the examiner object on grounds other than §112, second paragraph, Applicants request specific reasons.

#### **REJECTION UNDER 35 USC § 112, FIRST PARAGRAPH**

Claims 50-52 are rejected under 35 U.S.C. §112, first paragraph as lacking enablement. The Examiner refers to the rejections as those set forth in the paper mailed June 1, 2004. In reviewing the June 1, 2004 rejection, the Examiner asserts finding no written description for "FLP, Cre, R, Gin, PIV, FlmB, C31, KW, SSV, IS1110IS492, TnpX, AG, AGL5, Bcp1, LAT52, PLENA, SIM, avrRp2 and alc". The Examiner invited Applicants to point out in the specification where the terms are found.

In view of Applicants' amendments to the claims, denoting pollen-specific inducible promoters, as described in the specification at [0062] where Bcp1 and LAT52 are listed. Applicants contend that the claims are not unduly broad and that, based on the description and the detailed examples, one of skill in the art can readily envision and practice the invention. It is merely a matter of choosing well-known and available inducible pollen specific promoters, not requiring undue experimentation. It is further submitted that the claims are not unduly broad as the promoter is more definitely defined as to type and with specific examples.

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### **REQUEST FOR FURTHER CONSIDERATION**

Applicants recognize that this response is filed after Final Office Action. In view of the long prosecution and efforts of the Applicants to respond to the Examiner's concerns, Applicants request reconsideration of the currently amended claims.

Applicants have made a bona fide attempt to conform the claims to the working example and the examples in the description. It is submitted that no new matter is introduced that would impose additional burden on the Examiner.

### **Conclusion**

It is believed that the claims are in condition for allowance and reconsideration is respectfully requested. Should the Examiner have any questions, comments or suggestions, the undersigned requests a telephone conference at the number provided.

Respectfully submitted,

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